

REMARKS

In the Office Action, the Examiner rejected claims 29-31 under 35 U.S.C. § 101 as non-statutory; rejected claims 32-34 under 35 U.S.C. § 112; rejected claims 1-5, 7-17, and 20-28 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,725,053 to Rosen; and rejected claims 29-37 under 35 U.S.C. 103(a) as being unpatentable over Rosen in view of U.S. Patent No. 5,729,536 to Doshi.

By this amendment, Applicants amend claims 1, 14, 15, 20, 24, 26, 27, 28, and 29 and further amend claim 29 in response to the rejection under 35 U.S.C. § 101. Applicants submit that the amendments are supported by the specification.

Regarding the rejection under 35 U.S.C. § 101, Applicants submit that the amendment to claim 29 obviates the basis of the rejection of claim 29, as well as claims 30-31 by reason of their dependency from claim 29.

Regarding the rejection under 35 U.S.C. § 112, Applicants submit that the Examiner's position regarding "single means" is misplaced as claims 32-34 are not in means plus function form.¹

The Examiner rejected claims 1-5, 7-15, and 20-28 under 35 U.S.C. 103(a) as being unpatentable over Rosen. Applicants respectfully traverse this rejection.

Claim 1 recites a combination including, for example, "including in a message floor status information of a data communication media in relation to a party of a

¹ Since 1994, the Federal Circuit's law has held that both courts and the PTO must limit the scope of a means-plus-function limitation to the corresponding structure disclosed in the specification. *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193 & 1195, 29 USPQ2d 1845 (Fed. Cir. 1994) (*en banc*). Hence, the rationale of *Hyatt* that a single-means claims is unpatentable because it claims "every conceivable means for achieving the stated result" is no longer correct, at least in view of *Donaldson*.

communication session, the message carrying data communication media information for the communication session, the message configured as at least one of an offer and an answer of a session description protocol.”

In contrast to claim 1, Rosen describes a transmission privilege that generally allows a single user to transmit information to other net members at a given time. Rosen, column 3, lines 57-59. The transmission privilege is granted or denied to a requesting net member, depending on whether or not the transmission privilege is currently assigned to another net member when the request is received. Rosen, column 3, lines 59-63.

However, rather than use the session establishment mechanisms already in place, Rosen uses separate channels (e.g., the NBS media signaling channel 212). Moreover, although Rosen mentions the use of session data protocol (SDP). The SDP is used within the separate NBS signaling channel 212. Specifically, Rosen states:

In one embodiment, SIP channel **210** is used to start and end participation of a CD within the NBS net **100**. A session description protocol (SDP) signal may also be used within SIP channel **210**. When the CD's participation within the NBS net is setup, e.g., by using SIP channel **210**, real-time call control and signaling between the CD and the CM takes place, e.g., by using NBS media signaling channel **212**.

Rosen, col. 6, lines 59-62. Rosen's FIG. 2 (reproduced below) depicts the use of a SIP channel 210 and a separate NBS channel 212.

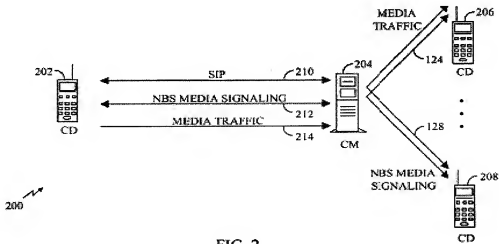


FIG. 2

Rather than communicate the floor control within the same mechanisms used to set up the session, Rosen **teaches away** by using a separate mechanism, e.g., NBS media signaling 212. As such, Rosen fails to disclose "including in a message floor status information of a data communication media in relation to a party of a communication session, the message carrying data communication media information for the communication session, the message configured as at least one of an offer and an answer of a session description protocol." Moreover, the Examiner's taking of Official Notice (with respect to the use of session data protocol), does not cure this noted deficiency. Therefore, claim 1 and claims 2-5 and 7-13 at least by reason of their dependency from claim 1, are allowable over Rosen, and the rejection of those claims under 35 U.S.C. 103(a) should be withdrawn.

Independent claims 14, 15, 20, 24, and 26-28, although of different scope, include features similar to some of those noted above with respect to claim 1. For at least the reasons given above, the rejection under 35 U.S.C. § 103(a) of claims 14, 15, 20, 24, and 26-28, as well as claims 21-23, and 25 at least by reason of their dependency, should be withdrawn.

The Examiner rejected claims 29-37 under 35 U.S.C. 103(a) as being unpatentable over Rosen in view of Doshi. Applicants respectfully traverse this rejection.

For at least the reasons noted above with respect to claim 1, Rosen fails to disclose the following feature of claim 29: "receiving a message describing a communication session, wherein the message carries data communication media information for the communication session and floor status information of a data communication media in relation to a party of the communication session, wherein the message has been generated in accordance with a session description protocol." Moreover, Doshi (which uses an ATM-based cellular infrastructure) does not cure the noted deficiencies of Rosen. Therefore, claim 29 and claims 30-31 at least by reason of their dependency from claim 29, are allowable over Rosen and Doshi, whether taken alone or in combination, and the rejection of those claims under 35 U.S.C. 103(a) should be withdrawn.

Independent claims 32 and 35, although of different scope, include features similar to some of those noted above with respect to claim 29. For at least the reasons given above, the rejection under 35 U.S.C. § 103(a) of claims 32 and 35, as well as claims 33-34 and 36-37, at least by reason of their dependency, should be withdrawn.

Regarding the motivation to combine, Rosen *teaches away* from claim 29 by using a separate mechanisms, as noted above.² Moreover, Doshi's disparate ATM-based system also teaches separate in-band and out of band mechanisms. Doshi, col. 1, lines 41-55. Therefore, one of ordinary skill in the art would not be motivated to make the Rosen and Doshi combination proposed by the Examiner. Therefore, the rejection under 35 U.S.C. § 103(a) of claim 29-37 should be withdrawn for this additional reason.

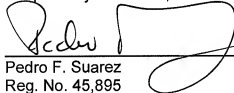
² MPEP §2141.02 further notes that "a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

CONCLUSION

On the basis of the foregoing amendments, the pending claims are in condition for allowance. It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Applicant is concurrently filing herewith a Request for Continued Examination with the requisite fee, authorization for a credit card payment of the filing fee is submitted herewith. No additional fees are believed to be due, however the Commissioner is authorized to charge any additional fees or credit overpayments to Deposit Account No. 50-0311, reference No. 39700-615001US. If there are any questions regarding this reply, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,



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